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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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DOUGLAS N. LARSON, ESQ.
OPPENHEIMER WOLFF & DONNELLY LLP
2029 Century Park East, Suite 3800
Los Angeles, CA 90067

EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,353

Applicant(s)

MCCARTHY ET AL.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-99 is/are pending in the application.
- 4a) Of the above claim(s) 12-50,63-75 and 90-99 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11,51-62 and 76-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6,8,10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-11, 51-62 and 76-89 in Paper No. 9 is acknowledged. It is noted that the restriction mailed on October 1, 2002 contained a typographical. The claims in group I should have included claim 62, and is here by incorporated into group I.

It is further noted that each independent claim is a different embodiment/species of the claimed printable card sheet construction. At this time a species restriction has not been made, since each embodiment is only slightly different. However, if upon amendment the species become sufficiently divergent in subject matter a species election will be required.

Information Disclosure Statement

2. The information disclosure statements filed December 7, 2001 (paper #6) and October 10, 2002 (paper #8) fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because they do not provide an English translation or English abstract for the foreign patents DE4240825A1 or DE19741563A1. They have been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the

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statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Specification

3. The abstract of the disclosure is objected to because it is more than 150 words.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 51-62 and 77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “adhesive-receptive coating” in claims 51 and 54 is unclear which renders the claims vague and indefinite. It is unclear from the claim language if there is a specific composition being claimed for the coating or if any coating will do.

Claims 51 and 54 are indefinite because they fail to set forth the composition or structure of the adhesive receptive coating and only claim properties of the coating. Claims that merely set forth physical characteristics desired in an article, and not setting forth specific compositions which would meet such characteristics are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the future. *Ex parte Slob* (PO BdApp) 157 USPQ 172.

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The term “ultraremovable adhesive” in claim 51 is unclear which renders the claim vague and indefinite. It is unclear how “ultraremovable adhesive” differs from ordinary adhesives on a release liner.

The term “ink jet/laser color-optimized coating” in claims 52 and 53 is unclear which renders the claims vague and indefinite. It is unclear from the claim language if there is a specific composition being claimed for the coating or if any coating will do.

Claims 52 and 53 are indefinite because they fail to set forth the composition or structure of the ink jet/laser color-optimized coating and only claim properties of the coating. Claims that merely set forth physical characteristics desired in an article, and not setting forth specific compositions which would meet such characteristics are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the future. *Ex parte Slob* (PO BdApp) 157 USPQ 172.

The term “printer receptive coat” in claim 58 is unclear which renders the claims vague and indefinite. It is unclear from the claim language if there is a specific composition being claimed for the coating or if any coating will do.

Claim 58 is indefinite because they fail to set forth the composition or structure of the printer-receptive coat and only claim properties of the coating. Claims that merely set forth physical characteristics desired in an article, and not setting forth specific compositions which would meet such characteristics are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the future. *Ex parte Slob* (PO BdApp) 157 USPQ 172.

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The phrase "method of" in claims 60-62 is unclear which renders the claims vague and indefinite. These claims are dependent from claim 51 which is a product claim "a printable card sheet construction" not a method of making claim. It is believed that they should read "the construction of."

The phrase "at least substantially the entire back side surface" in claim 76 is unclear which renders that claim vague and indefinite. It unclear how much the back side is cover by the liner sheet.

The phrase "substantially tack-free" in claim 77 is unclear which renders the claim vague and indefinite. It is uncertain to what degree the back side is "tack-free."

Note: The limitation "the infeed end is calendered" is a process limitation. However, this process limitation does add structure to the end product by crushing, compressing, making the calendered end thinner. So, for purposes of examination any process that results in a crushed, compressed or thinner end is taken to anticipate the limitation "the infeed end is calendered," since the method of forming the product is not germane to the issue of patentability of the product itself.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 1, 3, 6, 8-10, 76-79, 84, and 85 are rejected under 35 U.S.C. 102(b) as being anticipated by Casagrande (5,782,497).

Casagrande discloses a dry laminate business form with removable cards (col. 1, lines 13-17). The laminate of the invention comprises a topside layer (facestock sheet) which contains writing, graphics or other indicia, a first adhesive layer, a translucent film (film layer) or paper layer, a cast coating (liner sheet), a second adhesive (liner sheet), and a base paper (liner sheet) (figure 1 and col. 2, lines 26-53). The cast coating has a greater affinity for the second adhesive layer than the film or paper layer, which enables the separation of the film or paper layer from the cast coating layer upon removal of the card with cast coating layer remaining attached to the adhesive layer (col. 2, lines 61-65). The top, first adhesive, and translucent film or paper layers are provided with die cut lines which define the business card (figure 1 and col. 2, lines 40-43). From figure 1 it can be seen that the liner sheet covers the entire backside of the translucent film layer except for a narrow strip along a leading edge of the facestock sheet.

8. Claims 6, 9, 10 and 76-79 are rejected under 35 U.S.C. 102(b) as being anticipated by Oliver et al. (5,632,842).

Oliver discloses a business form with removable label/card comprising a paper web with cut lines, an adhesive and a release liner (col. 3, lines 11-19 and figure 4). From figure 4 it can be seen that the release liner substantially covers the entire back of the facestock material. The release liner is further provided with a suitable coating (such as silicone) (col. 2, lines 62-63).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 51, 54, 57, 60-62 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein (5,198,275) in view of Oliver et al. (5,632,842).

Klein discloses a card stock sheet for making business cards (col. 2, line 47) or a label (col. 3, line 13) comprising a lift out panel (cardstock sheet) with rectangular score cuts (cut lines), an adhesive, and a backing sheet (liner sheet) with perforations (liner sheet cut lines, defining liner sheet strips) (figure 6). From figure 3 the laminate member can be seen to have rectangular score cuts (frame cut lines) and score cuts (grid cut lines) and the matrix of cards is surrounded by a waste facestock sheet perimeter.

Klein fails to disclose an "adhesive-receptive coating on the strip.

Oliver discloses a business form with removable label/card comprising a paper web with cut lines, an adhesive and a release liner (col. 3, lines 11-19 and figure 4). From figure 4 it can be seen that the release liner substantially covers the entire back of the facestock material. The release liner is further provided with a suitable coating (such as silicone) (col. 2, lines 62-63).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add a coating such as silicone as taught by Oliver to the backing sheet of Klein in order to help facilitate the release of the backing sheet to the adhesive.

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The exact spacing of the paper sheet is deemed to be a cause effective variable. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as combined spacing of the paper strip closest the end through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

11. Claims 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein (5,198,275) in view of Oliver et al. (5,632,842) as applied to claims 51, 54, 57, 60-62 and 84 above, and further in view of Hickenbotham et al. (4,704,317).

Klein and Oliver disclose all the limitations of the instant claimed invention except for card sheet of paper sheet is calendered.

Hickenbotham discloses crushing the corner of laeblstock for use in printers or copier to provide a diagonal path of relatively low stiffness (col. 6, lines 9-16). The low stiffness in the front edge of the sheet allows the sheet to be dispensed through the printer or copier with greater easier (col. 1, lines 38-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention to crush the edge of Klein as similarly taught by Hickenbotham. One of ordinary skill would be motivated to crush the edge of Klein because crushing the edge of Klein would provide a path of relatively low stiffness and would make the sheet of Klein easier to be dispensed through a printer.

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12. Claims 52, 53, 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein (5,198,275) in view of Oliver et al. (5,632,842) as applied to claims 51, 54, 57, 60-62 and 84 above, and further in view of Carlson (5,842,722).

Klein and Oliver disclose all the limitations of the instant invention except that the cardstock comprises a printer-receptive/ink jet/laser coating.

Carlson discloses a sheet for preparing business forms including die cut cards, which includes an ink receptive coating (abstract and col. 19, line 50 through 3).

It would have been obvious to one of ordinary skill in the to ass an ink receptive coating to the cards of Klein as taught by Carlson because it would enhance the adhesion of the ink to the card.

The exact thickness of the layers is deemed to be a cause effective variable with regard to size of paper acceptable for sending through a printer. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as combined thickness of layers through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to change the size of the layers in order to accommodate the machine in which the sheet was intended to be used in.

13. Claims 2, 4, 5, 11, 80-83 and 86-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casagrande (5,782,497) in view of Klein (5,198,275).

Casagrande discloses all the limitations of the instant invention except that the printable media comprises a matrix block of cards and surrounded by waste facestock, the size of the narrow strip, and thickness of the layers.

Klein discloses a card stock sheet for making business cards (col. 2, line 47) or a label (col. 3, line 13) comprising a lift out panel (cardstock sheet) with rectangular score cuts (cut lines), an adhesive, and a backing sheet (liner sheet) with perforations (liner sheet cut lines, defining liner sheet strips) (figure 6). From figure 3 the laminate member can be seen to have rectangular score cuts (frame cut lines) and score cuts (grid cut lines) and the matrix of cards is surrounded by a waste facestock sheet perimeter.

The exact width of the strip is deemed to be a cause effective variable. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as combined the strip width through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

The exact thickness of the layers is deemed to be a cause effective variable with regard to size of paper acceptable for sending through a printer. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as combined thickness of layers through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to change the size of the layers in order to accommodate the machine in which the sheet was intended to be used in.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to arrange the cards of Casagrande similar to the arrangement of Klein to include a waste perimeter and a matrix of cards because it would make manufacturing mass quantities of the cards faster and easier.

14. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Casagrande (5,782,497).

Casagrande discloses the claims invention except for the adhesive is an emulsion acrylic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an emulsion acrylic adhesive, since it have been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. Further more, as evidenced by references 6,099,927, 6074,747, and 5,908,209, emulsion acrylic adhesives are well known in the label/facestock art.

Conclusion


15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

12/8/02



HAROLD PYON
SUPERVISORY PATENT EXAMINER
1/12

12/8/02